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UNITED STATES PATENT AND TRADEMARK OFFICE
Docket No. 14809US02

In the Application of:

Reusche et al.

Serial No.: 10/643,055

Filed: August 18, 2003

For: Water Agitation System for Water
Retention Structure

Examiner: Trinh T. Nguyen

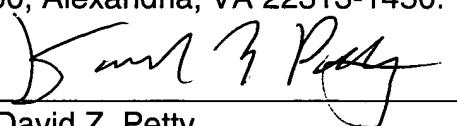
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Date: June 19, 2006

REPLY TO EXAMINER'S ANSWER PURSUANT TO 37 C.F.R. § 41.41

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Sir:

The Applicants respectfully submit this brief in reply to the Examiner's Answer to the Applicants' Appeal Brief. The Applicants note that this Reply Brief is timely because it is being filed within two months of May 23, 2006, which was the mailing date of the Examiner's Answer. The Applicants respectfully request that the Board of Patent Appeals and Interferences reverse the final rejection of claims 1-12, 14-25, and 27-34 of the present application.

I. Introduction

The Examiner's Answer essentially repeats the same arguments for rejecting claims 1-12, 14-25, and 27-34 that the Examiner made in the January 31, 2006 Final Office Action and fails to address the arguments presented by the Applicants in the Appeal Brief. The Applicants respectfully submit that a review of the Applicants' arguments from the Appeal Brief will show that the Examiner's rejections are misplaced and that claims 1-12, 14-25, and 27-34 are in condition for allowance.

II. Kajisono Does Not Anticipate Independent Claims 1, 14, or 27

The Examiner's Answer maintains that claims 1-5, 7, 8, 10, 12, 14-18, 20, 21, 23, 25, 27-30, and 33 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,336,399 ("Kajisono"). However, the Applicants have clearly shown in the Appeal Brief (and previous responses) that Kajisono does not teach, nor suggest, all the limitations of independent claims 1, 14, or 27.

A. Kajisono Does Not Teach Or Suggest An Agitator/Blade Assembly Extending From The Drive Shaft

Kajisono does not teach, nor suggest, an "agitator comprising at least one agitation member outwardly extending from a lateral surface of said distal end of said drive shaft" as recited in claim 1, "a blade assembly extending outwardly from said drive shaft" as recited in claim 14, or "an agitator having at least one blade outwardly extending from a lateral surface of said drive shaft" as recited in claim 27. The Examiner has repeatedly argued that column 4, lines 40-50 and Figure 7 of Kajisono

disclose “the use of impellers/agitation member/blade assembly outwardly extending from a lateral surface of the distal end of the drive shaft.” See, e.g., Examiner’s Answer at p. 8. However, Kajisono only discloses a **capsule** 32 that is **connected** to the drive shaft 30; the capsule is **not part of the drive shaft**. Kajisono at column 4, lines 38-49. The “members” shown in Figure 7 – and asserted by the Examiner to be “impellers” – **extend from the capsule 32 and not from the drive shaft 30 itself.** *Id.* at Fig. 7. Kajisono clearly does not disclose an agitator/blade assembly that extends from the drive shaft itself, and therefore Kajisono does not anticipate claims 1, 14, and 27. The Examiner’s Answer does not address this argument and merely repeats the rejection of record for claims 1, 14, and 27. The Applicants respectfully maintain that Kajisono does not teach nor suggest an agitator/blade assembly that extends from the drive shaft itself. Thus, at least for this reason, the Applicants respectfully submit that Kajisono does not anticipate claims 1, 14, and 27.

B. Kajisono Does Not Teach Or Suggest An Agitator Extending From A Lateral Surface Of A Drive Shaft

Kajisono does not disclose an agitator having at least one blade/member outwardly extending from a **lateral surface** of the drive shaft as recited in claims 1 and 27. Rather, in Figure 7, Kajisono discloses un-numbered and un-referenced curved lines downwardly extending from the **bottom of the capsule** 32 and not from a **lateral surface** of the drive shaft. Even assuming the curved lines shown in Figure 7 are “impellers” as the Examiner asserts, they simply do not outwardly extend from a **lateral**

surface of the drive shaft. Again, the Examiner's Answer has failed to address this argument and continues to incorrectly assert that the curved lines that extend from the bottom of the capsule in Kajisono outwardly extend from the lateral surface of the drive shaft. The Applicants respectfully maintain that Kajisono does not describe, teach, or suggest at least one blade/member outwardly extending from a **lateral surface** of the drive shaft. Thus, at least for this reason, the Applicants respectfully submit that Kajisono does not anticipate claims 1, 14, and 27.

C. Kajisono Does Not Teach Or Suggest Agitation Members Or Blades Stirring Water Within The Water Retention Structure

Kajisono also fails to teach or suggest "said motor configured to rotate said agitator in order to stir water retained within the water retention structure, wherein said at least one agitation member is operable to stir the water within the water retention structure" as recited in claim 1, "said motor operable to rotate said blade assembly in order to stir water retained within the water retention structure" as recited in claim 14, and "one blade . . . that is rotatably driven by said motor in order to stir water retained within the water retention structure" as recited in claim 27. Just as in the final rejection, the Examiner continues to argue that these limitations are taught in column 4, lines 40-50 and Figure 7 of Kajisono. *See, e.g.,* Examiner's Answer at p. 8.

Kajisono does not disclose a motor configured to rotate blades in order to stir water within the water retention structure. Rather, Kajisono discloses that the capsule 32 "may serve as a kind of propeller to cause **negative pressure** in the vicinity of the

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lower end of the outer casing when the drive shaft is rotated" and "it is preferable to provide impellers . . . so as to **cause increased negative pressure.**" Kajisono at col. 4, lines 44-49. Kajisono thus discloses impellers that specifically operate to create negative pressure in the capsule 32 in order to draw fluid into the capsule 32 so that bubbles are ejected from the capsule 32, and not to stir the water. Indeed, the Examiner has previously acknowledged that Kajisono does not teach blades stirring water within a water retention structure. See January 31, 2006 Office Action at p. 7. ("Applicant further argues that Kajisono does not teach the blades stirring water within the water retention structure, the Examiner acknowledges the argument."). However, the Examiner's Answer seemingly ignores this argument and maintains the rejection. The Applicants respectfully submit that Kajisono does not describe, teach, or suggest a motor configured to rotate blades in order to stir water within the water retention structure. At least for this reason, the Applicants respectfully submit that Kajisono does not anticipate claims 1, 14, and 27.

The Examiner's Answer also maintains the argument that blades stirring water is an "intended or desired use and is not a positive limitation but only requires the ability to so perform [and] therefore, it does not constitute a limitation in any patentable sense" and "that it is well settled case law that such limitations, which are essentially method limitations . . . do not serve to patentably distinguish the claimed structure over that of a reference." See Examiner's Answer at p. 9. However, the Applicants have shown in their Appeal Brief that the more recent case law clearly indicates that

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functional limitations **can be considered** in determining the patentability of an apparatus claim. *See In re Stencil*, 828, F.2d 751, 755 (Fed. Cir. 1987) (“Stencil is not inhibited from claiming his driver, limited by the statement of its purpose, and further defined by the remaining clauses of the claims at issue, when there is no suggestion in the prior art of a driver having the claimed structure **and purpose.**”) (emphasis added); *K-2 Corp. v. Salomon S.A.*, 191 F.3d 1356, 1363 (Fed. Cir. 1999) (“The functional language is, of course, an additional limitation in the claim.”); *Ethyl Molded Prods. Co. v. Betts Package Inc.*, 9 U.S.P.Q.2d 1001, 1030 (E.D. Kent. 1988) (“[A]ll limitations in a claim must be considered. The functional limitations in the ‘851 Patent clearly distinguish . . . over the prior art, which never suggested those functions.”). The Examiner’s Answer does not address this case law supporting the Applicants’ position, and the Applicants respectfully submit that in light of this case law, the Examiner’s rejection has no basis.

The Examiner’s Answer also maintains the argument that “when the impellers/agitation member/blade assembly rotates, the water around and/or surround [sic] the impellers/agitation member/blade assembly will be stirred somewhat.” Examiner’s Answer at p. 9. As the Appellants pointed out in their Appeal Brief, however, the Examiner provides no support for this conjecture, and Kajisono, in fact, teaches away from this limitation by disclosing impellers that specifically operate to create negative pressure in the capsule 32 in order to draw fluid into the capsule, and not to stir the water. *See* Kajisono at col. 4, lines 44-49. Again, the Examiner’s Answer

does not address this argument; rather the Examiner's Answer simply repeats the unsupported statement of conjecture regarding stirring as a basis for rejection. Therefore, for at least these reasons, the Applicants respectfully submit that Kajisono does not anticipate claims 1, 14, and 27.

The Examiner also argues that claim 1 uses the functional language of "configured to rotate said agitator in order to stir water," and that as so long as Kajisono teaches a motor similar to the motor of claim 1, then the Kajisono motor is configured to perform that function of rotating the agitator in order to stir water. Examiner's Answer at p. 9. However, as discussed above, the motor of Kajisono is **not similar** to the motor recited in claim 1 for the very reason that the Kajisono motor is configured to move the capsule to "cause negative pressure in the vicinity of the lower end of the outer casing when the drive shaft is rotated," and not to stir the water. Kajisono at col. 4, lines 44-49. Therefore, Kajisono does not teach nor suggest a motor that is similar to the motor recited in claim 1, *i.e.*, a "motor configured to rotate said agitator in order to stir water retained within the water retention structure," and does not anticipate claim 1.

D. Kajisono Does Not Teach Or Suggest A Base Removably Interconnected To A Cover

Kajisono does not explicitly describe, or inherently disclose, "a base removably interconnected to a cover," as recited in claim 1, "said cover being removably interconnected to said base" as recited in claim 14, or "a base removably secured to a

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cover" as recited in claim 27. Kajisono discloses that "[t]he base plate 10 is provided with a cover 16 for enclosing the motor 40 in a water resistant manner," but Kajisono does not disclose the base plate being **removably interconnected** to the cover. Kajisono at column 4, lines 5-6. The Examiner has repeatedly argued in the rejections of record and the Examiner's Answer that Figure 1 of Kajisono shows that the cover 16 is removably interconnected to the base by "fastener means" located around the base. See, e.g., Examiner's Answer at p. 9. While Kajisono shows un-numbered and un-referenced button-like protrusions extending upwardly from the lip of the cover 16 in Fig. 1, there is **absolutely nothing** in Kajisono to indicate that these protrusions are fasteners, and to assert otherwise is pure conjecture. Furthermore, even if one were to assume that these protrusions are fasteners, there is **absolutely nothing** in Kajisono to lead one to believe that these are features that removably interconnect a base to a cover. Again, the Examiner's Answer did not address these arguments and persists in arguing that the unidentified protrusions of Fig. 1 are removable fasteners. However, the Applicants respectfully submit that Kajisono does not describe, teach, or suggest a base removably interconnected or secured to a cover. At least for this reason, the Applicants respectfully submit that Kajisono does not anticipate claims 1, 14, and 27.

III. Claims 6, 19, And 31 Are Not Obvious In View Of Official Notice or Bengel

The Examiner originally rejected claims 6, 19, and 31 as being unpatentable over Kajisono in view of Official Notice. See September 29, 2005 Office Action. The Applicants challenged the Examiner's assertion of Official Notice in the Applicants'

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November 15, 2005 Response, and in response, the Examiner has cited U.S. Patent No. 5,465,279 (“Bengel”) for purposes of appeal as having been substituted for the Official Notice. See January 31, 2006 Office Action at p. 8, Examiner’s Answer at p. 10.

The Applicants have argued that claims 6, 19, and 31 are not unpatentable because the combination of Kajisono and Bengel does not teach, nor suggest, all the limitations of claims 6, 19, and 31. Moreover, the Examiner has not provided any suggestion or motivation for a person of skill in the art to combine such disparate technologies as the water purifier of Kajisono with the nuclear reactor coolant systems of Bengel to arrive at the inventions of claims 6, 19, and 31. The Examiner has responded by arguing that because “Bengel stands for the basis [sic] premise of having two structural members connecting to one another wherein a seal member interposed between the two structural members so as to create a water-tight seal between the two structural members . . . one of ordinary skill in the art would indeed look to the teaching of Bengel to learn how to provide a water-tight seal between two connecting members by interposing a seal member between the two connecting structural members.” Examiner’s Answer at pp. 10-11.

In order for a *prima facie* case of obviousness to be established, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the teaching. Manual of Patent Examining Procedure MPEP at § 2142, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added). The law is

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well settled that “[o]bviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion . . . or incentive to do so.” *ACS Hospital Systems, Inc. v. Montfiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929 (Fed. Cir. 1984).

It is not permissible to pick and choose among the individual elements of assorted prior art references to re-create the claimed invention, but rather “some teaching or suggestion in the references to support their use in the particular claimed combination” is needed. *Symbol Technologies, Inc. v. Opticon, Inc.* 935 F.2d 1569, 1576, 19 USPQ2d 1241 (Fed. Cir. 1991). Federal Circuit “case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.” *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). The “examiner can satisfy the burden of showing obviousness of the combination ‘only by showing some **objective** teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.’” See *in re Lee* , 277 F. 3d 1338, 1343 (Fed. Cir. 2002) citing *In re Fitch*, 972 F. 2d 1260, 1265 (Fed. Cir. 1992) (emphasis added).

The rejection of record and the Examiner’s Answer have not offered any **objective** teaching to support the conclusion that the water purifier that is disclosed in Kajisono may be combined with the housing used to test decontamination in a nuclear reactant coolant system that is disclosed in Bengel. Instead, the rejection of record and

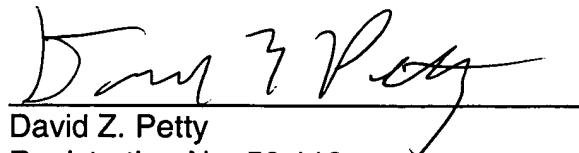
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the Examiner's Answer offer only subjective opinion as support. The Examiner provides no explanation for why a person of skill in the art of water purifiers would be motivated to look to Bengel, which is related to nuclear reactor coolant systems, to combine Kajisono with Bengel to arrive at the inventions of claims 6 19, and 31. Instead, it appears the Examiner merely picked and chose among isolated, individual elements of completely unrelated prior art references to re-create the Applicants' claimed invention, and thus did not produce a *prima facie* case of obviousness. For at least these reasons, claims 6, 19, and 31 are patentable.

IV. Conclusion

As discussed above, the Applicants respectfully submit that the pending claims are allowable in all respects. Therefore, the Board is respectfully requested to reverse the rejections of pending claims 1-12, 14-25, and 27-34. No fee is believed due with respect to this Reply Brief. The Commissioner is authorized, however, to charge any necessary fees or credit overpayment to Deposit Account 13-0017.

Respectfully submitted,



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